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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,864	04/13/2004	Hiroshi Ichikawa	64903-024	2673
7590 MCDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			EXAMINER KUMAR, KALYANAVENKA K	
		ART UNIT 3653	PAPER NUMBER	
		MAIL DATE 07/26/2007	DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/822,864	ICHIKAWA ET AL.
	Examiner Kalyan Kumar	Art Unit 3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 April 2007.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-25 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9-23, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al (USP 6,128,402).

Regarding claim 1,9-12, 14-19, 21, 22, and 25, Jones discloses a banknote handling system comprising a money in-out slot (1), a conveyance module (16), multiple banknote discrimination modules (8), a banknote storage box (9), a collection and reject box (col. 8, lines 49-52), and a control unit (34) that controls a management module (30) and updates the source data that includes a transaction record ID and transactor information comprising an account number and an employee number (10b).

Regarding claim 2 and 3, Jones discloses a temporary storage (11l), and a deposit cancellation process (11d, 11h, 11p).

Regarding claim 13, Jones discloses a banknote-sorting module (col. 9, lines 19-21).

Regarding claims 20 and 23, Jones discloses a step that obtains transactor information (10b), a step for banknote discrimination (11b), a step that stores a genuine banknote in the banknote storage box (10a), a step that manages mapping of the

transactor information and the banknote discrimination (10i), a step that feeds out stored banknotes for banknote discrimination (16), a step that collects banknotes that are determined to be counterfeit (11f), a step that updates the mapping to said banknote storage box (10i).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Hirose (**USP 4,554,444**).

Regarding claim 4, Jones discloses all the limitations of claim 1 and a money-out process. Jones does not disclose a money-out process that feeds banknotes from the banknote storage box. Hirose teaches a money-out process that feeds banknotes from the banknote storage box for the purpose of the deposited banknotes being used as banknotes for withdrawal (col. 2, lines 18-19). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Jones's banknote handling system with a money-out process, as taught by Hirose, for the purpose of the deposited banknotes being used as banknotes for withdrawal.

Regarding claims 6-8, Jones discloses all the limitations of claim 1 and a detachable cassette (col. 8, lines 44-46). Jones does not disclose a banknote feed

process that supplies banknotes to the banknote storage box from a place other than the money in-out slot. Hirose teaches a banknote feed process that supplies banknotes to the banknote storage box from a place other than the money in-out slot for the purpose of separately depositing notes of several denominations (col. 1, lines 63-66). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Jones's banknote handling system with a banknote feed process that supplies banknotes to the banknote storage box from a place other than the money in-out slot, as taught by Hirose, for the purpose of separately depositing notes of several denominations.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of **Guibord et al (USP 4,340,150)**.

Regarding claim 5, Jones discloses all the limitations of claim 1. Jones does not disclose a left-money collection process that stores or collects a banknote. Guibord teaches a left-money collection process that stores or collects a banknote for the purpose of recovering dispensed cash or notes automatically in certain conditions when abnormal or erroneous operation has been detected (col. 1, lines 64-66). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Jones's banknote handling system with a left-money collection process that stores or collects a banknote, as taught by Guibord, for the purpose of recovering dispensed cash or notes automatically in certain conditions when abnormal or erroneous operation has been detected.

Claim 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of **Yukimoto et al (USP 5,605,214)**.

Regarding claim 24, Jones discloses all the limitations of the claim, but Jones does not teach the management module manages the source data with a banknote number sequentially allocated to each banknote stored in the banknote storage boxes and when a banknote is fed from the banknote storage boxes, the control unit changes the banknote number allocated to the banknote. Yukimoto teaches the management module manages the source data with a banknote number sequentially allocated to each banknote stored in the banknote storage boxes and when a banknote is fed from the banknote storage boxes, the control unit changes the banknote number allocated to the banknote for the purpose of sequentially stacking and accumulating the authentic banknotes (col. 1, lines 17-22). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Jones's banknote handling system to store banknotes sequentially, as taught by Yukimoto, for the purpose of sequentially stacking and accumulating the authentic banknotes.

Response to Arguments

Applicant's arguments filed 4/20/2007 have been fully considered but they are not persuasive.

Regarding Claim Objection

Claim objection withdrawn due to applicant's amendment.

Regarding USC 112 Rejection

Rejection withdrawn due to applicant's amendment.

Regarding USC 102 Rejection

In response to applicant's argument that the Jones reference does not allow for banknote discrimination of each banknote in an other than money-in process, the reference's control system checks the genuineness of each bill and coin that is counted, whether it is a deposit or a withdrawal (col. 3, lines 27-26).

In response to applicant's argument that the Jones reference does not mention management of each banknote, the reference's management of banknotes picks out one bill at a time to scan for denomination and genuineness (col. 13, lines 21-30) and then stores the information on each transaction. The reference is storing source data for each banknote by transaction and therefore has source data for each banknote.

Regarding USC 103 Rejection

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, of claims 4 and 6-8, the motivation to combine is a banknote transaction apparatus can be used to

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deposit banknotes, discriminate banknotes, and withdraw banknotes (col. 2, lines 18-19).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, of claim 5, the motivation to combine is an improved note dispensing system can have to automatically recover banknotes that have been dispensed but not taken for some reason (col. 1, lines 64-66).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan Kumar whose telephone number is 571-272-8102. The examiner can normally be reached on Mon-Fri 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Kalyan Kumar
Examiner
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